

### REMARKS

The present application is directed to a method of preparing an article or premix, based on volatile corrosion inhibitor compositions, and a process of using the same, in particular to protect metal parts against corrosion. By this amendment, Claims 1-10 are cancelled and Claims 11-27 are new. Accordingly, Claims 11-27 will be pending following entry of this amendment. No new matter is introduced by the amendments and support for the new claims may be found throughout the specification. Applicants respectfully request reconsideration of the present claims in view of the amendments and following remarks.

Most of the amendments performed are informal. These informal amendments were performed in order to better conform with U.S. practice, e.g. in all new claims, the wording "*characterized in that*" has been replaced by "*wherein*", the wording "chosen from the group comprising" has been replaced by "selected from the group consisting of".

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112 and 35 U.S.C. § 101**

Claims 9 and 10 were rejected under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 101. These rejections are now moot as Claims 9 and 10 have been cancelled. Applicants respectfully request withdrawal of this rejection.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

Claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 1-8 have been cancelled and thus this rejection is rendered moot. Claims 1-8 have been replaced by Claims 11-18 which have been redrafted. Applicants assert that new Claims 11-18 clearly define the claimed subject matter.

It is now clear that at least one constituent of the packaging article comprises a premix and one component selected from the group consisting of at least one polymer and at least one filler.

The premix, the at least one polymer and the at least one filler are also clearly defined.

#### **New Claim 11**

New Claim 11 corresponds to original Claim 1 which has been redrafted. The use of terms “*either*” and “*or*” has been avoided in order to clarify the Claim. In new Claim 11, it is specified that the structuring agent is a solid or pasty substance which can be formed from a liquid substance when mixed with a mineral filler. Support can be found on page 5, lines 12 to 14. In new Claim 11 the term “*insoluble*” has been deleted with regard to the filler.

Further, in new Claim 11, the wording “*by means of which the release of volatile corrosion inhibitors is limited to a maximum when the composition or premix is formulated*” is replaced by “*which is effective to reduce the release of said volatile corrosion inhibitors when said packaging article or premix is formulated*”.

#### **New Claims 12 to 18**

New Claims 12 to 18 correspond to original Claims 2-8. New Claim 13 is also amended with respect to Claim 3 in that the preferred ranges of percentages and temperatures are deleted.

With respect to Claim 8, new Claim 18 now specifies that “*oxido nitrogen-containing derivatives*” means “*reaction products of oxido nitrogen-containing derivatives*”. It is also now specified that these reaction products of oxido nitrogen-containing derivatives have a “*vapor pressure of at least  $10^{-5}$  mm Hg at 20°C*”. Support for this amendment is found on page 2, lines 5 to 9. For the above reasons, Applicants respectfully request withdrawal of the previous 35 U.S.C. § 112, second paragraph rejection.

#### **DOUBLE PATENTING**

Applicants acknowledge the provisional double patenting objection raised by the Examiner in connection with co-pending patent application No. 10/031,472. This objection will be addressed upon allowance of the present Claims.

**CLAIM REJECTIONS UNDER 35 U.S.C. § 103 or 35 U.S.C. § 102**

Claims 1-8 were rejected under 35 U.S.C § 103 or 35 U.S.C. § 102 over Bortolussi et al. (hereafter "*Bortolussi*" (BR 90-01035). In particular the Examiner remarked that *Bortolussi* "discloses two part formulations for volatile corrosion inhibitors in which the 'primary' part comprises the volatile corrosion inhibitor and processing aid which reduces friction and shearing level so that lower temperature may be employed, and the secondary part is a polymer of 80-95 weight percent of the final formulation". Furthermore, the examiner stated the processing aid may be amines, amides and glycols and concluded that it would have been obvious to one of ordinary skill in the art to employ polyethylene glycol instead of the other processing aids.

This rejection is respectfully traversed. Applicants' invention is based on the finding that the efficiency of the packaging article is highly increased when the volatile corrosion inhibitor used for the manufacture thereof is prevented from evaporating or decomposing during the manufacture of the packaging article.

According to the present invention, the volatile corrosion inhibitor used for the manufacture of the packaging article is prevented from evaporating or decomposing during the manufacture of the packaging article by incorporating it in a premix. The premix is formed by blending the volatile corrosion inhibitor with a pasty or solid structuring agent having a low melting point of between 40°C and 110°C.

*Bortolussi* et al. fails to teach or suggest incorporating the volatile corrosion inhibitor with a pasty or solid structuring agent having a low melting point of between 40°C and 110°C to prevent the evaporation of the volatile corrosion inhibitor.

Accordingly, the packaging article as recited in Claim 11 is novel and not obvious over *Bortolussi* et al. For at least the reasons given above, Applicants respectfully submit that the new Claims are allowable over the art of record. Accordingly, Applicants respectfully request withdrawal of this rejection.

Fessler et al. (U.S. 2,829,080), Boerwinkle et al. (U.S. 4,290,912), Bortolussi et al. (BR 9,001,035) and Lozano et al. (U.S. 6,033,599) all disclose mixtures of volatile corrosion inhibitors with polymers, however none of the cited art, teaches or suggests the combination of elements as claimed, namely the combination of a premix, and a

component selected from the group consisting of at least one polymer and at least one filler. Thus the cited references do not anticipate the invention of the instant application.

Similarly, Wachter et al. (U.S. 2,643,176) and Ruzevick et al. (U.S. 3,425,954) disclose the use of volatile corrosion inhibitors with wax, but fail to teach or suggest the combination of elements, as claimed in the current invention. Therefore, Applicants respectfully submit that the cited art does not anticipate or render obvious the present application, as claimed.

The Examiner cited Cooke et al. (hereafter "*Cooke*") (U.S. 2,758,981) as anticipating or rendering obvious the non-elected embodiment in which the premix constituent is "insoluble filler" selected from the group consisting of mineral fillers, i.e. sodium nitrite. The Applicants respectfully emphasize that sodium nitrite is not a structuring agent within the meaning of the invention or a volatile corrosion inhibitor. Sodium nitrite is a contact corrosion inhibitor. It is only when sodium nitrite is reacted with ammonium (ammonium benzoate as in Example 1), that it results in a volatile corrosion inhibitor (see also page 2, lines 15 to 19 of the instant application). Thus, the fact that *Cooke* et al. disclose the use of sodium nitrite as a contact corrosion inhibitor does not anticipate or render obvious the claimed invention in which volatile corrosion inhibitors are used. For at least the reasons given above, Applicants respectfully submit that the cited art does not employ the claimed invention of mineral waxes in a premix with volatile corrosion inhibitors and further formulated with at least an equal weight of polymer. Therefore the combination of volatile corrosion inhibitor, mineral wax and polymer, in the order and proportional limitations set forth, is allowable over the art of record. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 and 35 U.S.C. § 102.

#### **New Claims 19 and 20**

New Claims 19 and 20 recite process steps for preparing the packaging article of Claim 11. Support for these new Claims is found on page 12, lines 19 to 24 and on page 12, lines 25 to 28.

**New Claims 21 and 22**

New Claims 21 and 22 recite process steps for protecting metal parts using the packaging article of Claim 11. Support for these new Claims is found, respectively, on page 11, lines 16-19 and on page 12, lines 8-14.

**New Claims 23 to 24**

These new Claims recite preferred embodiments of Claim 11.

**New Claims 26 and 27**

These new Claims recite preferred percentage ranges of Claim 13.

### CONCLUSION

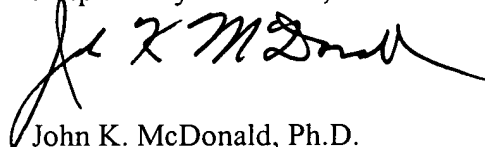
For at least the reasons given above, Applicants submit that Claims 11-28 define patentable subject matter. Accordingly, Applicants respectfully request allowance of the Claims.

The foregoing is submitted as a full and complete Response to the Office Action mailed June 6, 2003 and early and favorable consideration of the claims is respectfully requested. This response is timely filed in view of the concurrently filed Petition for a Three Month Extension of Time and the required fee.

Should the Examiner believe that anything further is necessary in order to place this application in better condition for allowance, the Examiner is respectfully requested to contact the Applicants representative at the telephone number listed below.

No additional fees are believed due, however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John K. McDonald', is written over the typed name.

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